

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 15, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

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In re Tabacalera Palma, Ltd.

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Serial No. 88866282

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Frank Herrera and Gustavo Sardiña of H New Media Law,
for Tabacalera Palma, Ltd.

Katrina J. Joiner, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Acting Managing Attorney.

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Before Shaw, Pologeorgis, and Johnson,
Administrative Trademark Judges.

Opinion by Pologeorgis, Administrative Trademark Judge:

Tabacalera Palma, Ltd. (“Applicant”) seeks registration on the Principal Register of the standard character mark AMERICAN STOGIES (STOGIES disclaimed) under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), for “cigars” in International Class 34.¹

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¹ Application Serial No. 88866282, filed on April 9, 2020, based on an allegation of use in commerce pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming June 11, 2001 as both the date of first use and the date of first use in commerce.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(e)(3) of the Trademark Act, 15 U.S.C. § 1052(e)(3), on the ground that Applicant's proposed mark is primarily geographically deceptively misdescriptive of the identified goods.²

When the refusal was made final, Applicant appealed and requested reconsideration. When the request for reconsideration was denied, the appeal resumed. The appeal is fully briefed. For the reasons explained below, we reverse the refusal to register.³

I. Geographically Deceptively Misdescriptive – Applicable Law

Section 2(e)(3) of the Trademark Act prohibits registration of marks that are primarily geographically deceptively misdescriptive of the identified goods or services. A mark is primarily geographically deceptively misdescriptive if:

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the goods do not come from the place named in the mark, but the relevant public would be likely to believe that the goods originate there; and
- (3) the misrepresentation is a material factor in the purchaser's decision to buy the goods in question.

² The Examining Attorney also refused registration under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). The Section 2(a) refusal was withdrawn by the Examining Attorney in her April 21, 2021 Final Office Action. The Examining Attorney, however, maintained and continued the Section 2(a) refusal in her denial of Applicant's request for reconsideration, *see* November 9, 2021 Denial of Request for Reconsideration, but did not address this ground for refusal in her appeal brief. Thus, this ground for refusal is waived and will be given no further consideration.

³ The TTABVue and Trademark Status and Document Retrieval (TSDR) citations refer to the docket and electronic file database for the involved application. All citations to the TSDR database are to the downloadable .pdf version of the documents.

In re Miracle Tuesday, LLC, 695 F.3d 1339, 104 USPQ2d 1330, 1332 (Fed. Cir. 2012); *In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1489, 1490-95 (Fed. Cir. 2009); *In re California Innovations*, 329 F.3d 1334, 66 USPQ2d 1853, 1857 (Fed. Cir. 2003); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1210.01(b) (July 2022).

In determining “materiality,” the Board has stated that it looks to evidence regarding the probable reaction of purchasers to a particular geographical term when it is applied to particular goods. *See In re House of Windsor, Inc.*, 221 USPQ 53, 56 (TTAB 1983), *recon. denied*, 223 USPQ 191 (TTAB 1984). Materiality may be established inferentially based on indirect evidence such as gazetteer entries and third-party websites. *See Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1098 (TTAB 2012). If the evidence shows that the geographical area named in the mark is sufficiently known to lead purchasers to make a goods/place association, but the record does not show that the relevant goods are a principal product of that geographical area, the deception will most likely be found not to be material. *See* TMEP § 1210.05(c)(i). If, however, there is evidence that the relevant goods, or related goods, are a principal product of the geographical area named by the mark, then the deception will most likely be found to be material. *Id.*

Furthermore, evidence that a place is famous as a source of the goods at issue raises an inference in favor of materiality. *In re Compania de Licores Internacionales S.A.*, 102 USPQ2d 1841, 1850 (TTAB 2012); *see also In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1542 (Fed. Cir. 2003). Such evidence supports a presumption that a substantial portion of the relevant consumers is likely to be

deceived.

Thus, to establish the materiality element for goods, the evidence must show that:

- (1) The place named in the mark is famous as a source of the goods at issue;
- (2) The goods in question are a principal product of the place named in the mark; or
- (3) The goods are, or are related to, the traditional products of the place named in the mark, or are an expansion of the traditional products of the place named in the mark.

See California Innovations, 66 USPQ2d at 1857; *In re Save Venice N.Y., Inc.*, 259 F.3d 1346, 1355, 59 USPQ2d 1778, 1784 (Fed. Cir. 2001); *Compania de Licores Internacionales*, 102 USPQ2d at 1850; *House of Windsor*, 221 USPQ at 57.

II. Arguments and Evidence

The Examining Attorney argues that the term AMERICAN in Applicant's proposed mark is likely to create the impression that Applicant's identified goods originate in the United States, when in actuality they do not.⁴ In support of her argument, the Examining Attorney submitted the following dictionary definitions of the term "AMERICAN":⁵

- **www.merriam-webster.com**
 - 1: an American Indian of North America or South America
 - 2: a native or inhabitant of North America or South America
 - 3: a native or inhabitant of the U.S.

⁴ Examining Attorney's Appeal Brief, p. 4; 12 TTABVUE 5.

⁵ September 28, 2020 Office Action (TSDR 4 and 12); April 21, 2021 Office Action (TSDR 6, 10, and 33); November 9, 2021 Denial of Request for Reconsideration (TSDR 7 and 12).

- **www.ah.com (The American Heritage Dictionary)**

1: Of or relating to the United States of America or its people, language or culture

2: Of or relating to North or South America, the West Indies, or the Western Hemisphere

- **www.macmillandictionary.com**

1: Someone who is American is from the U.S.

- **www.wornik.com**

1: Adj. Of or relating to the United States of America its people, language or culture

2: Adj. Of relating to North or South America, the West Indies, or the Western Hemisphere

- **www.wordsmith.com**

1: Of, or pertaining to, or characteristic of the United States, or its people, culture, language, government, or the like.

2: Of, or pertaining to, or in North, Central or South America.

- **www.collinsdictionary.com**

1: Of or pertaining to the United States of America or its inhabitants.

2: Of or pertaining to North or South America of the Western Hemisphere.

- **www.dictionary.com**

1: Of or pertaining to the United States of America or its inhabitants.

2: Of or pertaining to North or South America; of the Western Hemisphere.

The Examining Attorney also refers to Applicant's involved application which

states that Applicant is a legal entity from the Dominican Republic.⁶ Additionally, the Examining Attorney references one of the specimens submitted by Applicant with its application that describes Applicant’s identified goods as being handmade in Nicaragua with “premium Honduran and Nicaraguan long-filler tobaccos.”⁷ The specimen is reproduced below:⁸



While the Examining Attorney acknowledges that the countries of Nicaragua and the Dominican Republic are a part of the AMERICAS, the Examining Attorney nonetheless argues that these countries are not a part of the United States, which is the geographic location considered as AMERICA, or something originating in the

⁶ Applicant’s submitted specimens (TSDR 2).

⁷ *Id.* (TSDR 8).

⁸ The blue arrow is provided by the Board for emphasis.

United States of America when the term AMERICAN is used, for the purpose of determining whether a mark filed for registration with the USPTO is geographically descriptive or primarily geographically deceptively misdescriptive.⁹

The Examining Attorney further maintains that Applicant's proposed AMERICAN STOGIES mark is likely to be perceived as indicating the United States as the geographic origin of the goods in question because the Applicant is seeking registration in the U.S. where the consuming public is presumed to be consumers from the United States and who are considered to be American as the definitions of record demonstrate.¹⁰ As such, the Examining Attorney maintains that when U.S. consumers see the term AMERICAN used in connection with products marketed and sold in the United States of America, they are likely to perceive that the goods originated in the U.S., when, in fact, this is not the case.¹¹

Lastly, the Examining Attorney argues that a significant portion of relevant U.S. consumers would be materially influenced in the decision to purchase Applicant's product by the geographic meaning of Applicant's proposed mark.¹² In support of this argument, the Examining Attorney submitted screenshots from the website of a U.S. cigar manufacturer in Ybor City, Florida, (who sells cigars under the brand name THE AMERICAN) which states on its face that there is an honored American tradition of cigar rolling resulting in the production of "world-class cigars in America

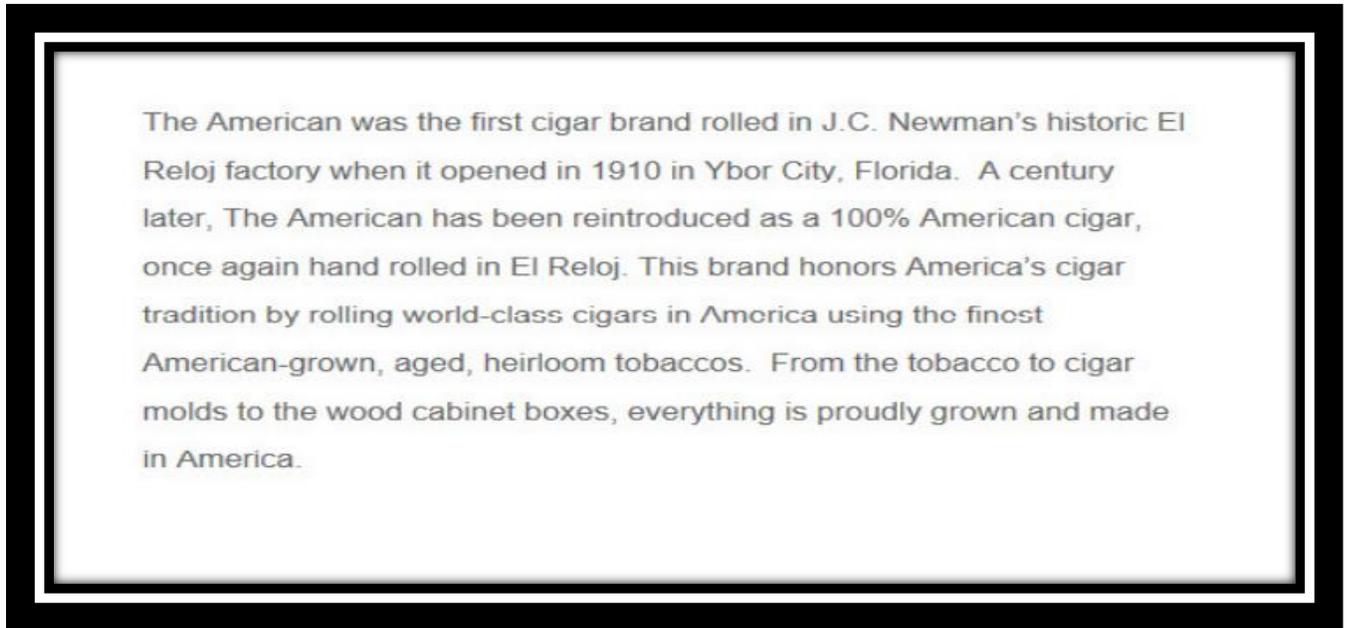
⁹ Examining Attorney's Brief, p. 4; 12 TTABVUE 5.

¹⁰ *Id.* at p. 7; 12 TTABVUE 8.

¹¹ *Id.*

¹² *Id.* at p. 6; 12 TTABVUE 7.

using the finest American-grown, aged, heirloom tobaccos.” The relevant portion of the screenshots from the website is reproduced below:



In contesting the refusal, Applicant argues that the word “AMERICAN” is a geographic term that includes North America, South America, Central America, and the West Indies, which encompasses the countries of Nicaragua and the Dominican Republic.¹³ In other words, Applicant contends, contrary to the Examining Attorney’s position, that the use of the geographic term AMERICAN is not limited to only the United States.¹⁴ In support of its argument, Applicant references the dictionary definitions submitted by the Examining Attorney which include definitions that define the term AMERICAN as “[o]f relating to North or South America, the West

¹³ Applicant’s Appeal Brief, p. 1 (4 TTABVUE 2).

¹⁴ *Id.*

Indies, or the Western Hemisphere.”¹⁵ In further support of its argument, Applicant submitted the following evidence: (1) a printout of the Wikipedia entry for “Americas” which defines “[t]he Americas (also collectively called America)” as “a landmass comprising the totality of North and South America,”¹⁶ (2) printouts from the CIA World Facebook entries for Nicaragua, the Dominican Republic and Honduras, which identifies these countries as part of “America,” namely, “Central America,”¹⁷ and (3) printouts for the entry “Countries of the Americas” from the website www.nationsonline.org which defines “America” in terms of its parts, namely, North America, the Caribbean, Central America, and South America.¹⁸ Additionally, Applicant references certain specimens it submitted with its involved application arguing that these specimens are consistent with its interpretation of the term “American” and focuses consumer’s attention on the definitions of “American” which relate to the indigenous people of the Americas. The specimens are reproduced below:¹⁹

¹⁵ *Id.* at p. 6 (4 TTABVUE 7).

¹⁶ March 23, 2021 Response to Office Action, Exh. C (TSDR 66-99).

¹⁷ *Id.*, Exhs. D, E, and F (TSDR 100-153).

¹⁸ *Id.*, Exh. G (TSDR 154-163).

¹⁹ Applicant’s submitted specimens (TSDR 1)



More specifically, Applicant contends that that use of the traditional headdress featured on its cigar bands is not exclusive to the indigenous people of the United States, but includes indigenous people throughout North America, South America and the Caribbean island of Hispaniola (an island divided into Haiti and the Dominican Republic).²⁰ In support thereof, Applicant submitted a Wikipedia entry for “Taino,” the indigenous people of the Caribbean, as well as screenshots from the online magazine titled “Guyana Folk and Culture” displaying Caribbean Taino and Guyana indigenous people in the traditional headdress. A representative sample of screenshots from the online magazine is reproduced below.²¹

²⁰ Applicant’s Appeal Brief, pp. 10-11 (4 TTABVUE 11-12).

²¹ March 23, 2021 Response to Office Action, Exhs. A and B (TSDR 15-65).

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THE ART OF FEATHER WORK
CACHUCHABANA
FEATHER HEADDRESSES OF THE TAINO PEOPLES
By Jorge Baracuteli Estevez, leader of the Sangre Taino Cultural Group



GCA 2017 Awards Lifetime Achievement and Exemplary awards honored with Cacique Crowns

Headdresses are worn by native peoples all around the world. They are beautiful, decorative and symbolic of identity, status and many other things. Among the most beautiful and elaborate headdresses are those made by the Indigenous peoples of the Western Hemisphere. The Indigenous peoples of the Americas are collectively called Native Americans, American Indian, Amerindians, Indigenous, American Aborigines, First Nations, Mestizos, Latino, etc.

Guyana Cultural Association of New York Inc. on-line Magazine

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Made from feathers, animal skins, reeds, grasses and a plethora of other materials, headdresses in some Native Cultures can only be worn by men. In most however, both men and women may wear them. Certain headdresses may be worn by both sexes while others are gender specific. In addition, each feather has a different value, such as the tail feathers are more valuable than the wing feathers, except for the tail feather and in particular the birds' Pointed and primary feathers. In some times it is said that each feather has "DUA" which is spiritual energy. Headdresses made from basketry or basket like materials are almost always worn by spiritual people.

Some headdress, in particular those made of feathers must be earned as is the case of the American Plains Indians. War bonnet, where an individual must earn each and every Eagle feather in battle in order to earn the right to wear that particular type of headdress. In South America, most tribes require that men, women and children wear headdresses. Thus owning and wearing a headdress is a responsibility of the individual. Feathers are gathered by hunting, collecting, trapped feathers, and by trade.

In some tribes a single individual may possess up to 32 different headdresses throughout his or her life. Some headdresses are for weddings, naming ceremonies, etc.

I began making headdress 5 years ago. I was reluctant to use or wear them until I understood their exact meaning. For the Taino people, who are in a state of re-emergence today, they are symbols of resistance and identity. In general, headdress symbolize love, honor, respect and beauty. They are connections to the spirit world as well as the physical world.

Guyana Cultural Association of New York Inc. on-line Magazine

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Guyana Cultural Association of New York Inc. on-line Magazine

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The art created by 9th season of SWS was also present at Family Fun Day and at the 50th anniversary celebrations of the West Indian Labor Day Celebrations on Brooklyn's Eastern Parkway.



Members of the Impressions Dance Theater and GCA Summer Heritage Workshop Interns on Eastern Parkway, Labor Day 2017.
 Photograph by Tangerine Clarke.
 Photo first published in Caribbean Life, September 7, 2017.

Guyana Cultural Association of New York Inc. on-line Magazine

Finally, Applicant argues that the evidence submitted by the Examining Attorney is insufficient to establish that a significant portion of relevant U.S. consumers would

be materially influenced in the decision to purchase Applicant's cigars because of the geographic meaning of Applicant's proposed mark.²² Specifically, Applicant argues that the single piece of evidence submitted by the Examining Attorney regarding the materiality element of the primarily geographically deceptively misdescriptive refusal does not establish that a significant portion of relevant U.S. consumers would be materially deceived.²³ Applicant contends that the Examining Attorney incorrectly interprets the screenshots from the third-party online cigar retailer as being a source which "shows that there is a particular type of American cigar made in the United States and as such, the applicant's use of AMERICAN in their mark indicates to consumers that their goods are of such style and origin, when in fact they are not."²⁴ Applicant maintains that there is no "such style" of cigar and nothing in the submitted screenshots that defines the "style" of an "American cigar" as being distinct from any other cigar. Thus, Applicant concludes that this evidence does not establish that a significant portion of relevant U.S. consumers would be deceived or that the geographic nature of the term AMERICAN would be material to the relevant U.S. consumer's purchasing decision.

III. Analysis

As previously noted, under Section 2(e)(3) of the Trademark Act, a mark may not be registered on the principal register if the mark, "when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive

²² Applicant's Appeal Brief, p. 9 (4 TTABVue 10).

²³ *Id.*

²⁴ *Id.* and September 28, 2020 Office Action (TSDR 2).

of them.” 15 U.S.C. § 1052(e)(3). A mark is primarily geographically deceptively misdescriptive, and thus barred from registration, if: (1) “the primary significance of the mark is a generally known geographic location”; (2) “the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark, when in fact the goods do not come from that place”; and (3) “the misrepresentation was a material factor in the consumer’s decision” to purchase the goods. *In re California Innovations, Inc.*, 66 USPQ2d at 1857.

Whether a mark is geographically deceptively misdescriptive is a question of fact. *See In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1178 (Fed. Cir 2001). Likewise, whether a geographic location is known for particular goods is a question of fact. *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865, 868 (Fed.Cir.1985).

Under the first prong of the test — whether the mark’s primary significance is a generally known geographic location — we note that Applicant does not contest that the primary significance of the term “AMERICAN” in its proposed mark denotes a generally known geographic location. Applicant does dispute, however, that the geographic term “AMERICAN” only pertains to the United States or its inhabitants. We acknowledge that the dictionary definitions of record define “AMERICAN” to include “[o]f, or pertaining to, or in North, Central or South America,” which encompasses the country of Nicaragua (the country of origin of Applicant’s goods). That being said, we note that there is no evidence of record that relevant U.S. consumers would view the term “AMERICAN,” when used as part of a trademark or source indicator of goods, to indicate that these goods originated in countries other

than the United States. Instead, because the first or primary definitions of “American” refer to the United States, we find that relevant U.S. consumers, upon encountering the term AMERICAN as part of a trademark or source indicator for goods, would reasonably believe that the goods originated in the United States.²⁵

As to the second prong, there is evidence of record, albeit a limited amount, that cigars are manufactured in the United States²⁶ and, therefore, the relevant U.S. consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark. Additionally, there is evidence of record (which Applicant does not contest) that Applicant’s goods originate from Nicaragua and not the United States. Thus, the second prong is satisfied.

Lastly, we turn to the prong regarding materiality. The only evidence submitted by the Examining Attorney to support the contention that a significant portion of relevant U.S. consumers would be materially influenced in the decision to purchase Applicant’s cigars in light of the geographic meaning of Applicant’s proposed mark are screenshots from a single website of a third-party cigar manufacturer located in Ybor City, Florida. We do not find this evidence sufficient. First, there is nothing in

²⁵ In addition, we also make the following points regarding the geographical nature of the term “AMERICAN” for “cigars.” First, we note that Applicant’s proposed mark is not merely the term “AMERICAN,” but “AMERICAN STOGIES.” Applicant, however, has disclaimed the word “STOGIES.” The fact that Applicant has included highly descriptive or generic wording along with its geographically descriptive term does not convert a geographic term into a non-geographic term. *See, e.g., In re Compagnie Generale Maritime*, 993 F.2d 841, 26 USPQ2d 1652, 26 USPQ2d 1652 (Fed. Cir. 1993) (FRENCH LINE (stylized) primarily geographically descriptive of goods and services from France); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (“The addition of a generic term to a geographic term does not avoid the refusal of primary geographic descriptiveness”).

²⁶ Applicant does not contest that cigars are manufactured in the United States.

the record to indicate how often U.S. consumers have viewed this website. Second, the screenshots are merely an advertisement of a third-party cigar manufacturer touting the attributes of its product. While the third-party cigar manufacturer does state on its website that its cigar brand “honors America’s cigar tradition by rolling world-class cigars in America using the finest American-grown, aged, heirloom tobaccos,” we find this language mere trade puffery and nonetheless does not demonstrate that (1) the United States is famous for producing a particular style of cigar, or (2) that cigars manufactured in the United States are a principal product of the U.S or are of premium quality. In sum, the Examining Attorney has not submitted sufficient evidence on the critical element of materiality to support the refusal to register.

IV. Conclusion

The burden of proving that Applicant’s AMERICAN STOGIES proposed mark is primarily geographically deceptively misdescriptive rests with the Examining Attorney. Based on the evidence of record, we find that the Examining Attorney has satisfied her burden in establishing that (1) the primary significance of Applicant’s proposed mark is a generally known geographic location; and (2) Applicant’s goods do not come from the place named in the mark, but the relevant public would be likely to believe that the goods originate there. That being said, we find that the evidence submitted by the Examining Attorney does not satisfy her burden of establishing that a significant portion of relevant U.S. consumers would be materially influenced in the decision to purchase Applicant’s product by the geographic meaning of Applicant’s proposed mark.

We hasten to add, however, that our decision does not constitute endorsement or approval of the mark but merely recognizes that the Trademark Act presumes that a mark should be approved for publication in the absence of appropriate evidence that it is not registrable. We note that our decision is without prejudice to any inter partes proceeding which might be filed by an aggrieved party. It is possible that we would reach a different result on a more complete record such as may be adduced in an inter partes proceeding.

Decision: The refusal to register Applicant's AMERICAN STOGIES mark under Section 2(e)(3) of the Trademark Act on the basis that the mark is primarily geographically deceptively misdescriptive of the goods is reversed.